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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BLAISE ALEXANDER,
JOAN M. FALLS,
LES PUGLIA, and
MATTHEW YEAGER

Appeal 2009-013084
Application 10/002,948
Technology Center 3600

Decided: July 15, 2010

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Blaise Alexander et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1 and 3-27. We have jurisdiction under 35 U.S.C. § 6(b) (2002). Claims 2 and 28-31 is canceled.

SUMMARY OF DECISION

We AFFIRM-IN-PART.²

THE INVENTION

This invention is a method and system for leasing motor vehicle to credit challenged consumers. Specification [0002].

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method for leasing a motor vehicle to a credit challenged customer comprising the steps of:

selecting a vehicle based on predetermined financial criteria;

approving a lease for the vehicle;

funding the lease; wherein funding the lease comprises:

establishing a leasing company by an auto dealership;

acquiring a line of credit from a lending institution by the leasing company for providing a pool of funds for a plurality of leases, the line of credit including an interest based upon a plurality of credit parameters associated with the dealership;

² Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Dec. 4, 2008) and Reply Brief ("Reply Br.," filed Jun. 8, 2009), and the Examiner's Answer ("Answer," mailed Apr. 16, 4009).

selecting and installing into the vehicle a device configured to render the vehicle operable for a predetermined period of time, the vehicle otherwise being inoperable with the installed device;

activating the device to render the vehicle operable for a predetermined lease period after receiving a predetermined lease payment from the customer for the predetermined lease period; and

delivering the vehicle to the customer.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

| | | |
|-----------|-----------------|---------------|
| Highbloom | US 5,323,315 | Jun. 21, 1994 |
| Simon | US 6,195,648 C1 | Oct. 10, 2006 |
| Streit | EP 0 762 363 A1 | Mar. 12, 1997 |

Robyn Meredith, *A Car with a Catch When Credit is Bad*, N.Y. Times, Aug. 30, 1999, at A15. [Hereinafter Robyn.]

The Examiner took Official Notice that, “establishing a leasing company and acquiring a line of credit, the line of credit including an interest is old and well known in the business of leasing as a convenient way for [a] company to provide customer integrated service in a timely and efficient manner.” Answer 5. [Hereinafter, Official Notice I.]

The Examiner took Official Notice that “means for to compute predetermined financial parameter in electronic form based on financial parameter is old and well known in the business of leasing as a convenient way for company to provide customer integrated service in a timely and efficient manner [sic].” Answer 6. [Hereinafter, Official Notice II.]

The Examiner took Official Notice that “the line of credit is substantially equal to an amount of business anticipated is old and well

established in the business of funding lease for a motor vehicle [*sic*].”

Answer 7. [Hereinafter, Official Notice III.]

The Examiner took Official Notice that “the customer’s need based on payment the customer can afford is old and well established in the business of funding lease for a motor vehicle [*sic*].” Answer 7. [Hereinafter, Official Notice IV.]

The Examiner took Official Notice that “select vehicle model base on the leasing term is old and well established in the automobile leasing industry to assist the leasing company to select vehicle for its customer [*sic*].” Answer 8. [Hereinafter, Official Notice V.]

The Examiner took Official Notice that “select vehicle base on mileage or lease term is old and well established in the automobile leasing industry to assist the leasing company to select vehicle for its customer e [*sic*].” Answer 8. [Hereinafter, Official Notice VI.]

The Examiner took Official Notice that “lease has a cost not greater than certain percentage of retail value is old and well established in the automobile leasing industry to assist the leasing company to select vehicle for its customer [*sic*].” Answer 8. [Hereinafter, Official Notice VII.]

The Examiner took Official Notice that “the step of approving the lease is performed by a reviewer is old and well established in the business of funding lease for a motor vehicle.” Answer 9. [Hereinafter, Official Notice VIII.]

The following rejections are before us for review:

1. Claims 1, 8, 10-12, and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Robyn and Official Notice I, evidenced by Highbloom.

2. Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Robyn, Official Notice I, evidenced by Highbloom, and Official Notice III.
3. Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Robyn, Official Notice I, evidenced by Highbloom, and Official Notice IV.
4. Claim 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over Robyn, Official Notice I, evidenced by Highbloom, and Official Notice V.
5. Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Robyn, Official Notice I, evidenced by Highbloom, and Official Notice VI.
6. Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over Robyn, Official Notice I, evidenced by Highbloom, and Official Notice VII.
7. Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over Robyn, Official Notice I, evidenced by Highbloom, and Official Notice VIII.
8. Claims 13-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Robyn, Official Notice I, evidenced by Highbloom, and Simon.
9. Claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over Robyn, Official Notice I, evidenced by Highbloom, and Streit.

10. Claims 19, 21-22, and 25-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Robyn and Official Notice II.
11. Claim 20 is rejected under 35 U.S.C. §103(a) as being unpatentable over Robyn, Official Notice II, and Official Notice III.
12. Claims 24, and 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over Robyn, Official Notice II, and Simon.
13. Claims 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Robyn, Official Notice II, and Streit.
14. Claim 7 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

ISSUES

The first issue is whether Claims 1 is unpatentable under 35 U.S.C. §103(a) over Robyn and Official Notice I, evidenced by Highbloom. Specifically, whether the Examiner improperly took official notice and whether Robyn teaches the recited step of funding the lease, which comprised establishing a leasing company and acquiring a line of credit as recited in claim 1. The Examiner's rejections of claims 3-20, 23, and 24 under 35 U.S.C. § 103(a) also turn on this issue.

The second issue is whether the Examiner has established that claim 20 is unpatentable under 35 U.S.C. § 103(a) over Robyn, Official Notice II, and Official Notice III.

The third issue is whether the Examiner has established that claim 7 is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention under 35 U.S.C. § 112, second paragraph.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Robyn's paragraph [31] states: "About \$13 million of that money will be used to finance up to 1,200 additional leases on vehicles with the on-time devices . . ."
2. The Specification's paragraphs [0041] and [0042] describe that upon authorizing a lease, the lending institution fund a vehicle sales contract by depositing money into a leasing company's account and that, if the leasing company is different than the vehicle dealership, the leasing company will transfer the money to the vehicle dealership.
3. The Specification states: "These examples and embodiments are intended as typical of, rather than in any way limiting on, the scope of the present invention as presented in the appended claims." Specification [0053].

ANALYSIS

The rejections of claims 1, 8, 10-12, 18, and 19 under §103(a).

The Appellants argue claims 1, 8, 10-12, 18, and 19 as a group. App. Br. 4-11. We select claim 1 as the representative claim for this group, and the remaining claims 8, 10-12, 18 and 19 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2009).

The Appellants argue: 1) that the Examiner improperly took official notice in a final office action (App. Br. 6-8); and 2) that Robyn does not teach the recited step of funding the lease, which comprised establishing a leasing company and acquiring a line of credit as recited in claim 1 (App. Br. 9-11 and Reply Br. 4-7).

First, the Appellants argue that the Examiner has improperly taken Official Notice because “[t]he Examiner has not presented the explicit basis on which the examiner regards the matter as subject to Official Notice and Applicants have not been allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.” App. Br. 8.

However, we find that the Examiner did explicitly take notice of the subject matter which the Examiner considered old and well known. *See* Answer 5 (“*Official Notice is taken that . . .*”). Further, we note that the Appellants have been allowed and are actually challenging the Examiner’s Official Notice in the Appeal Brief (App. Br. 6-8), which is the next reply after the Office Action in which the common knowledge statement was made.

As to the merits of the Appellants’ challenge, the Appellants’ arguments do not traverse what the Examiner regards as knowledge that

would have been generally available to one of ordinary skill in the art at the time the invention was made. The Appellants' arguments do not appear to constitute an adequate traverse because the Appellants have not specifically pointed out why the noticed facts are not considered to be common

knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a).

An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art.

In re Boon, 439 F.2d 724, 728 (CCPA1971). The Appellants do not argue or assert that the subject matter of Official Notice I is not common knowledge or well-known in the art, therefore, we find that the Appellants' challenge is inadequate.

Second, the Appellants argue that Robyn does not teach the recited step of funding the lease, which comprises establishing a leasing company and acquiring a line of credit as recited in claim 1 (App. Br. 9-11 and Reply Br. 4-7). Specifically, the Appellants argue that: A) Robyn does not broadly teach the recited step funding a lease as asserted by the Examiner (App. Br. 9-10 and Reply Br. 4-7) and B) that Robyn does not teach establishing a leasing company and acquiring a line of credit (App. Br. 10-11 and Reply Br. 7).

Turning to argument A, among other citations, the Examiner quotes paragraph [31] of Robyn to teach the broad step of funding a lease. Answer 16. Robyn's paragraph [31] states: "About \$13 million of that money will be used to finance up to 1,200 additional leases on vehicles with the on-time devices . . ." FF 1. The Appellants argue that paragraphs [0041] and [0042] of the Specification "define" the step of funding the lease and that paragraph

[31] of Robyn does not “disclose funding the lease in the sense that limitation is used in the patent application.” Reply Br. 6-7.

However, we find no definition of “funding the lease” in paragraphs [0041] and [0042], but merely a description of funding the lease as described in the preferred embodiments. FF 2. Further, we note that the Specification states: “These examples and embodiments are intended as typical of, rather than in any way limiting on, the scope of the present invention as presented in the appended claims.” Specification [0053]. Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily) (“The problem is to interpret claims ‘in view of the specification’ without unnecessarily importing limitations from the specification into the claims.”). Therefore, we decline to read elements from paragraphs [0041] and [0042] of the Specification into the claims. We agree with the Examiner that paragraph [31] of Robyn teaches the claimed step of funding the lease.

Turning to argument B, the Appellants argue that the Robyn does not teach the steps of establishing a leasing company and acquiring a line of credit. App. Br. 10-11 and Reply Br. 7. The Examiner admits that Robyn does not teach these steps and took Official Notice I to teach these limitations. Answer 5. The Appellants’ arguments merely assert that Robyn does not teach these steps and do not address whether the combination of Robyn and Official Notice I teach these steps.

Accordingly, we find that the Appellants have not overcome the rejection of claims 1, and claims 8, 10-12, and 18 dependent thereon, under

35 U.S.C. § 103(a) as being unpatentable over Robyn and Official Notice I. Further, since the rejection of claim 19 stands or falls with claim 1 (App. Br. 4), we find that the Appellants have not overcome the rejection of claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Robyn and Official Notice II.

The rejection of claims 3-7, 9, and 20 under § 103(a).

The Appellants argue against the rejections of claims 3-7, 9, and 20 for the same reasons used to argue against the rejections of claims 1 and 19. App. Br. 11. Further, the Appellants again argue that the Examiner has improperly taken official notice. App. Br. 11-12. Because we found the Appellants' arguments unpersuasive as to the rejection of claim 1, we find them equally unpersuasive as to the rejections of claims 3-7, 9, and 20.

Accordingly, we find that the Appellants have not overcome the rejection of claim 3-7 and 9 under 35 U.S.C. § 103(a) and the rejection of claim 20 under 35 U.S.C. §103(a) as being unpatentable over Robyn, Official Notice II, and Official Notice III.

The rejection of claims 21-22 and 25-27 under § 103(a).

Claim 21 depends from claim 19 and further limits the means for obtaining recited in claim 19. The Examiner rejected claim 21 stating that “the specifics of the funding the lease and selected vehicle can be construed as non-functional descriptive material and are not functionally related to the method for leasing said selected vehicle.” Answer 9. The Appellants argue that “[t]he Examiner is improperly equating *printed matter* not functionally

related to the device with the *descriptive matter* set forth in claim[s] 21 . . .”
App. Br. 13 (emphasis original).

We agree with the Appellants. Claims 19 and 21 are directed to an apparatus not a method. The limitations of claim 21 related to the specifics of funding the lease are used to further define the *structure* of the means for obtaining recited in claim 19. The Examiner has not established that the *structure* encompassed by claim 19 is taught in the prior art.

Accordingly, we find that the Appellants have overcome the rejection of claim 21, and claims 22 and 25-17, dependent thereon, under 35 U.S.C. §103(a) as being unpatentable over Robyn and Official Notice II.

The rejection of claims 13-16 under § 103(a).

The Appellants argue against the rejection of claim 23 for the same reasons used to argue against the rejection of claim 1. App. Br. 14. Further, the Appellants argue that Simon does not cure the defect of Robyn and Official Notice I. *Id.* Because we found the Appellants’ arguments unpersuasive as to the rejection of claim 1, we find them equally unpersuasive as to the rejection of claims 13-16.

Accordingly, we find that the Appellants have not overcome the rejection of claims 13-16 under 35 U.S.C. § 103(a) as unpatentable over Robyn, Official Notice I, and Simon.

The rejections of claim 17 and 23 under § 103(a).

The Appellants argue against the rejections of claims 17 and 23 for the same reasons used to argue against the rejections of claims 1 and 19. App. Br. 15. Further, the Appellants argue that Streit does not cure the

defect of Robyn and Official Notice I. *Id.* Because we found the Appellants' arguments unpersuasive as to the rejections of claims 1 and 19, we find them equally unpersuasive as to the rejections of claims 17 and 23.

Accordingly, we find that the Appellants have not overcome the rejection of claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Robyn, Official Notice I, and Streit and the rejection of claim 23 under 35 U.S.C. § 103(a) Robyn, Official Notice I, and Streit.

The rejection of claim 24 under § 103(a).

The Appellants argue against the rejection of claim 24 for the same reasons used to argue against the rejection of claim 19. App. Br. 16. Because we found the Appellants' arguments unpersuasive as to the rejection of claim 19, we find them equally unpersuasive as to the rejection of claim 24.

Accordingly, we find that the Appellants have not overcome the rejection of claim 24 under 35 U.S.C. § 103(a) as unpatentable over Robyn, Official Notice II, and Simon.

The rejection of claim 7 under § 112, second paragraph.

In rejecting claim 7 under 35 U.S.C. § 112, second paragraph, the Examiner states: "The term 'currently published retail value' in claim 7 is vague and indefinite." Answer 3. The Appellants assert that reference publications used in the auto industry for financing and pricing vehicles are well known and therefore, the phrase is not vague and indefinite. App. Br. 16 and Reply Br. 7-8. While the Examiner acknowledge the Appellant's

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argument (*See* Answer 16), the Examiner does not respond to this argument (*See* Answer 16-17).

The test for compliance with 35 U.S.C. § 112, second paragraph, is whether the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the application disclosure as they would be interpreted by one of ordinary skill in the art. *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971). The Examiner has not established that the use of the phrase “currently published retail value” cause the one of ordinary skill in the art to be unable to discern the scope of claim 7. We find that the Examiner has not established a *prima facie* showing in rejecting claim 7 under 35 U.S.C. § 112, second paragraph, as indefinite.

Accordingly, we find that the Appellants have overcome the rejection of claim 7 under 35 U.S.C. § 112, second paragraph.

DECISION

The decision of the Examiner to reject claims 1, 3-20, 23, and 24 is affirmed and to reject claims 21, 22, and 25-27 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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